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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,840	01/08/2004	Joseph Armstrong Martin	R0159B-REG	6037

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ROCHE PALO ALTO LLC
PATENT LAW DEPT. M/S A2-250
3431 HILLVIEW AVENUE
PALO ALTO, CA 94304

EXAMINER

LEWIS, PATRICK T

ART UNIT PAPER NUMBER

1623

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/753,840	Applicant(s) MARTIN, JOSEPH ARMSTRONG	
	Examiner Patrick T. Lewis	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's Response Dated November 7, 2005

1. Claims 1-11 are pending. An action on the merits of claims 1-11 is contained herein below.
2. The rejection of claims 1-11 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is maintained for the reasons of record as set forth in the Office Action dated August 18, 2005.
3. The rejection of claim 11 under 35 U.S.C. 102(e) as being anticipated by Devos et al. US 6,784,166 has been rendered moot in view of applicant's amendment dated November 7, 2005.

Rejections of Record Set Forth in the Office Action Dated August 18, 2005

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
6. Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive. Applicant argues that the examiner has employed selective

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reading of Leyessen et al. (of record). Applicant has directed the examiner's attention to the text reading, "The intense search for inhibitors of HCV replication will probably result in the discovery of compounds that inhibit replication of Flaviviridae in general", for support of the arguments.

The examiner disagrees with applicant's assertion. Leyessen teaches that *Flaviviridae* are enveloped, positive single-stranded RNA viruses. This virus family contains three genera: *Hepacivirus*, *Flavivirus* and *Pestivirus*. Viruses belonging to different genera have different biological properties and do not show serological cross-reactivity. Leyessen further teaches the difficulty in treating specific viruses in the family *Flavivirus*. U.S.C. 112, first paragraph states that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Applicant has failed to fulfill this requirement. While the treatment of HCV using a compound of Formula I may be enabled, that is not what applicant claims. Applicant's method clearly is not intended to read upon the treatment of HCV.

No working examples are provided. No data is presented in support of applicant's claim of treatment of animals having a viral infection other than HCV with a compound of formula I. No in vitro data is presented suggesting viral activity of the instant compounds against a virus other than HCV. There is no suggestion of the use of art-recognized animal models by applicant in the specification. Leyessen is seen to be sufficient in establishing unpredictability in the art. When little is known in the prior

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art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. Accordingly, what is known in the prior art provides evidence as to the question of predictability. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, more guidance by or direction from applicant is needed.

The references cited in applicant's response have been noted; however, if applicant wishes to have a particular reference considered by the examiner, said reference should be submitted on a proper information disclosure statement. The examiner has not considered said references. The viral activity data shown in Table 1 of the response has also been noted; however, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, **when filed**, contained sufficient information regarding the subject matter of the claims to enable one skilled in the pertinent art to make and use the claimed invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph. Any negative limitation or exclusionary proviso must have basis in the original disclosure. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph.

Conclusion

9. Claims 1-11 are pending. Claims 1-11 are rejected. No claims are allowed.
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on Monday - Friday 10 am to 3 pm (Maxi Flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick T. Lewis, PhD
Primary Examiner
Art Unit 1623

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